

REMARKS

Responsive to the Office Action mailed September 13, 2006, Applicants provide the following. Twenty-six (26) claims remain pending: claims 21-34 and 36-47. Claim 37 has been amended without adding new matter. Applicants respectfully request reconsideration of claims 21-34 and 36-47 in view of the above amendments and the remarks below.

By way of this amendment, Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone the undersigned at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

Finality of Office Action In Error

1. Applicants respectfully submit that the finality of the pending office action is in error. In making the office action final, the Examiner states that the amendments to the claims necessitated the new grounds of rejection (office action, page 21). The prior response, however, did not amend any of the claims, and thus, no amendments necessitated the new grounds for rejections.

MPEP section 706.07 recites in part “[u]nder present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)” (MPEP §706.7(a)). The MPEP continues stating that “[i]f, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection” MPEP §706.7(d).

The Examiner has made the subject office action mailed September 13, 2006, Final based on the argument that the newly cited art was necessitated by the amendments made in the previous response (office action, page 21). However, no amendments were made to the claims in the previous response mailed August 14, 2006. The newly cited art was neither

necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c). Therefore the finality of the present office action is in error. Accordingly, Applicants respectfully request that the finality of the Office Action be withdrawn.

Claim Rejections - 35 U.S.C. § 103

2. Claims 21-23, 26-28 and 45-46 stand rejected under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 6,184,877 (Dodson et al.) in view of U.S. Patent No. 6,230,324 (Tomita et al.) in further view of U.S. Patent No. 6,865,746 (Herrington et al.). Applicants respectfully traverse these rejections, and further submit that claims 21-23, 26-28 and 45-46 are not obvious over the combination of above references.

More specifically, at least with respect to claim 21, the combination of the Dodson, Tomita and Herrington references, if arguendo one were to combine these references, does not teach or suggest each of the limitations as recited. For example, claim 21 recites in part "requesting a searching of a network for information relating to the keyword; and receiving the information including the preselected information relating to the key word." The combination of Dodson, Tomita and Herrington does not result in at least receiving information related to the key word as recited in claim 21. Specifically, Dodson only describes supplying "automatic search terms to be searched" (Dodson, col. 3, lns. 8-10), where the automatic search terms are not preassociated with preselected data, and are instead used to search for information not available with the information at the time the information is sent to the client, and is not preassociated with and cannot be preassociated with preselected information (Dodson, col. 4, lns. 42-51). Furthermore, the office action specifically states that Dodson fails to teach a "first code that is preassociated with preselected information relating to the key word prior to receiving the key word," and relies on Tomita (Office Action, pg. 4).

The office action suggests that Tomita describes this limitation since "keywords in the keyword database 32 can be found in transmitted information, corresponding addresses of information sources stored in the keyword database 32 may be attached to the keywords in the

transmitted information” (Office Action, pg. 4). Further, the office action suggests that modifying the Dodson automatic search term, which the office action equates with the first code, with the Tomita keyword teaches a first code preassociated with preselected information (Office Action, pg. 4). However, the combination, as suggested by the Office Action, fails to teach “requesting a searching of a network for information relating to the keyword; and receiving the information including the preselected information relating to the key word,” as recited. The Examiner equates the key word recited in claim 21 with a first search term described in Dodson, and equates the code recited in claim 21 with a second search term described in Dodson which includes preselected information as described in Tomita. However, requesting a search of the Dodson first search term does not result in receiving the preselected information associated with the Dodson second search term, since the search terms in Dodson are not associated with one another such that searching for one keyword would result in information relating to that keyword as well, *arguendo*, as preselected information preassociated with another keyword. Therefore, the search result of requesting for the first search term in Dodson, equated with the claimed keyword, will not include the information that is allegedly preassociated with the second search term, equated with the claimed first code.

Further, in Tomita “the keyword management unit 11 stores and manages one-to-one relationships between keywords and addresses of information sources which provide information matching the keywords” (Tomita, col. 4, lns. 8-12) so that information regarding the keyword can only be retrieved by selecting that specific keyword (see at least Tomita, col.14, lns. 4-7). Therefore, even if one were to combine the Dodson and Tomita patents, the combination would not teach at least requesting a searching of a network for information relating to the keyword; and receiving the information including the preselected information relating to the key word as claimed, because requesting a searching of the keyword (the first search term) would only result in the information related to that search term and not the preselected information. Therefore, the combination of the Dodson and Tomita references fails to teach all of the elements of claim 21.

The Herrington reference also fails to teach or suggest at least “a key word and a first code preassociated with preselected information relating to the keyword ... requesting a searching of a network for information relating to the keyword ... and receiving the information including the preselected information relating to the keyword” as recited in claim 21. Therefore, a *prime facie* case of obviousness has not been established by the combination of the Dodson, Tomita, and Herrington as suggested by the office action because the combination fails to teach each of the limitations as recited in claim 21, and thus, claim 21 is in condition for allowance.

Further, one skilled in the art would not combine the Tomita patent and the Dodson patent because the purpose of the Dodson patent is to provide search terms to access external data not available with the content at the time the content is transmitted to the client device; while Tomita describes a transmission device that “automatically attaches addresses of [known] information sources to keywords in program-guide information to the terminal device”, and therefore, requires that the information and/or the source of information be known at the time the program guide information is sent to the user (Tomita, col. 5, lns. 14-17). Further, in Tomita additional information about the keywords is limited to those keywords stored in the “keyword management unit 11” (Tomita, col. 4, 28-30), so that if the user wants to know about any information where the keyword is not stored the user will not be able to access the additional information. Dodson teaches away from this approach and specifically states that one of the shortcomings of the conventional program services is that “if the viewer desires to see other information related to a program ... the viewer is typically required to research the desired additional information elsewhere” (col. 1, lns. 45-52). There would be no motivation to combine the references since Dodson already describes having local data available with the content, “current program title, the actors starring in the program, the start time, and the end time” (see Dodson, col. 2, lns. 59-64). Further, Dodson teaches away from storing all of the data with the content as described by the Tomita reference since the Dodson patent states that having all channel information in one place “can be awkward and frustrating to the user” (see Dodson, col. 1, lns. 39-51). The Dodson patent teaches away from “static T.V. model of centralized channel information” where “all channel information is in one place” and instead describes “a system and

methods which avoids these problems in the conventional system for displaying TV program information” (Dodson, col. 1, lns. 38-55). In contrast, the Tomita reference describes a transmission device where all of the information about the keyword and information sources are stored in the “keyword management unit 11” and are static so that requesting a search of the key term will only result in accessing the stored information source associated with the keyword (see Tomita, col. 4, lns. 6-12). Further, when the programming information is sent by the transmission device described in Tomita, all of the information associated with the program is received by the display device and has to be stored (see Tomita, col. 4, lns. 64-67). As such, the system described in Dodson teaches away from receiving and having to receive and store all of the information as with the system described in Tomita. Therefore, one skilled in the art would not combine at least the Dodson patent with the Tomita patent. As such, claim 21 is not rendered obvious in view of Dodson, Tomita and Herrington.

Similarly, with respect to claim 45, the Examiner relies on the combination of the Dodson, Tomita and Herrington patents to teach the claimed limitations. At least for the reasons described above one skilled in the art would not combine at least the Dodson and Tomita patents. Therefore, claim 45 is also not obvious over the combination of Dodson, Tomita, and Herrington at least for the reasons described above with respect to claim 21, and thus, is in condition for allowance.

Claims 22-23, 26-28 depend from independent claim 21, and claim 46 depends from independent claim 45. Therefore, claims 22-23, 26-28 and 46 are also in condition for allowance at least due to their dependence on claims 21 and 45.

3. Claims 24, 29-30, 37, 39-41 and 43-44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,184,877 (Dodson et al.) in view of U.S. Patent No. 6,230,324 (Tomita et al.) and U.S. Patent No. 6,865,746 (Herrington et al) and in further view of U.S. Patent No. 6,499,057 (Portuesi). This rejection is respectfully traversed and reconsideration is requested.

Claims 24 and 29-30 depend from claim 21. As demonstrated above, the combination of Dodson, Tomita and Herrington fails to teach or suggest each of the limitations recited in claim 21. The Portuesi patent also fails to teach at least “a key word and a first code preassociated with preselected information relating to the keyword ... requesting a searching of a network relating to the keyword ... receiving the information including the preselected information relating to the keyword” as recited in claim 21, and therefore, does not provide any teaching or suggestion that, taken with the combination of Dodson, Tomita and Herrington, renders at least claim 21 obvious. Therefore, a *prima facie* case of obviousness also is not met with regard to at least dependent claims 24 and 29-30 due at least on their dependency on allowable claim 21.

Furthermore, the combination of Dodson, Tomita, Herrington and Portuesi fails to teach or suggest each of the limitations recited in amended claim 37. Claim 37 recites “receiving a keyword and a first code over a second communication channel, wherein the first code is preassociated with preselected information specific to the keyword prior to receiving the keyword”. The combination of the Dodson and Tomita patents does not teach at least a first code preassociated with preselected information specific to the keyword prior to receiving the keyword. The Examiner equates the keyword and first code to a first and second search term described in Dodson respectively, where the second search term is modified with respect to the keyword described in Tomita to include information associated with the keyword. However, the information associated with the second Dodson search term, equated to the claimed first code, is not specific to the first Dodson search term, equated to the claimed keyword. Instead, the information associated with the modified second Dodson search term (equated to the first code) is simply information relating to that search term and is not specific to the distinct first Dodson search term (see at least Tomita, col. 4, lns. 59-67). As such, the Dodson and Tomita combination fails to teach at least a first code preassociated with preselected information specific to the keyword prior to receiving the keyword as recited in at least claim 37. Further, at least for the reasons discussed above with respect to claim 21 one skilled in the art would not combine the Dodson and Tomita patent. As such, the combination of Dodson, Herrington, Tomita, and

Portuesi fails to teach or suggest at least the aforementioned elements as presently recited in claim 37. Accordingly, Applicants respectfully submit that claim 37 and claims 39-41, 43, and 44, which depends from claim 37, are not rendered *prima facie* obvious in light of the combined references.

4. Claim 25 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,184,877 (Dodson et al.) in view of U.S. Patent No. 6,230,324 (Tomita et al.) and U.S. Patent No. 6,865,746 (Herrington et al) in further view of U.S. Patent No. 5,819,284 (Farber et al.). This rejection is respectfully traversed and reconsideration is requested.

Claim 25 depends from claim 21. As demonstrated above, the combination of Dodson, Tomita and Herrington fails to teach or suggest each of the limitations as recited in claim 21. Farber also fails to teach at least those limitations as demonstrated above as not being taught by the combination of Dodson, Tomita and Herrington, and does not provide any teaching or suggestion that, taken with the combination of Dodson, Tomita and Herrington, renders claim 21 obvious. Therefore, a *prima facie* case of obviousness is not met with regard to at least dependent claim 25.

5. Claim 42 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,184,877 (Dodson et al.) in view of U.S. Patent Application Publication No. 2003/0204847 (Tomita et al.) and U.S. Patent No. 6,865,746 (Herrington et al) in further view of U.S. Patent No. 5,819,284 (Farber et al.) and U.S. Patent No. 6,499,057 (Portuesi). This rejection is respectfully traversed and reconsideration is requested.

Claim 42 ultimately depends from claim 37. As demonstrated above, the combination of Dodson, Tomita, Herrington, and Portuesi fails to teach or suggest each limitation as recited in claim 37. Farber also fails to teach at least “a key word and a first code preassociated with preselected information relating to the keyword ... requesting a searching of a network for information relating to the keyword ... and receiving the information including the preselected information relating to the keyword” as recited in amended claim 37, and therefore,

does not provide any teaching or suggestion that, taken with the combination of Dodson, Tomita, Herrington, and Portuesi, renders claim 37 obvious. Therefore, a *prima facie* case of obviousness is not met with regard to at least dependent claim 42.

6. Claims 31-34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,184,877 (Dodson et al.) in view of U.S. Patent App. Publication No. 2004/0040042 (Feinleib) and U.S. Patent No. 6,240,555 (Shoff et al.), in further view of U.S. Patent No. 6,499,057 (Portuesi). Applicants respectfully traverse these rejections.

With regard to at least claim 31, the combination of applied references does not teach at least “receiving keywords comprising a unique identifier of the storage medium associated with the video image over a second communication channel” as recited in claim 31. The office action specifically states that “the Dodson et al. and Feinleib combination does not specifically teach ‘keywords comprising a unique identifier of the storage medium’” (Office Action, pg. 17), and instead relies upon the Shoff patent.

The office action specifically suggests with regard to the Shoff patent that “in the case of supplemental content provided by servers, URL’s serve as target specifications (unique identifiers of the storage medium) that direct the device to specific storage mediums for the retrieval of storage medium” (Office Action, pgs. 3-4). However, the target specification referred to by the Office Action and described in Shoff, refers to identifiers of supplemental contents, and does not describe a unique identifier of the storage medium containing the video image as recited in at least claim 31. As described in Shoff, a “data structure 48 includes a data field 58 for holding target specifications which reference target resources supporting the supplemental content” where “the data structure correlates the target specifications with the programs by associating them within the same program record” (Shoff, col. 6, lns. 7-11). The target specifications in Shoff, therefore, do not refer to the video image or the medium storing the image, and instead refer to the supplemental content that may be accessed and played with the video image. The target specification information is provided so that at the time of playing the interactive media in Shoff supplemental content can be retrieved and played along with the

media. The target specification information can only be retrieved once the user knows what program is being accessed, and therefore, the target specification information is an identifier of the supplemental content and not the storage medium containing the video image. The target specification information of Shoff is an identifier of the supplemental content so that when the media is being played supplemental content for that media can be retrieved and played along with the media (Shoff, see at least col. 7, lns. 65-67).

Further, the office action attempts to equate URLs with the recited unique identifier of the medium, stating “[t]hus the Shoff et al. supplemental content retrieval system relies on unique identifiers for the storage medium (target specifications such as a URL)...” (office action, page 3). A URL, however, is not a unique identifier of a storage medium, but instead defines a protocol and a “server” from which the content can be accessed. Specifically, the Shoff patent states “[t]he URL describes the protocol a browser should use to retrieve the resource, the name of the computer it is on, and the path and file name of the resource” (Shoff, col. 6, lines 32-36). None of the protocol, the name of the computer or the path and file name are a unique identifier of the medium, but instead simply identify the supplemental content. Additionally as demonstrated above, the target specifications identify the supplemental content, and do not identify the medium. Therefore, the Shoff patent does not teach or suggest a “keywords comprising a unique identifier of the storage medium associated with the video image” as recited in claim 31, and thus, claim 31 is not obvious over the applied combination of references.

Additionally, the Shoff patent describes that when the supplemental content is read from a disk “the supplemental content is accessed via disk reads to the local storage drive, rather than using URLs to target resources over a network,” such that the storage medium does not need target specifications to access the supplemental content (Shoff, col. 7, lns. 65-67). As such, Shoff fails to teach receiving a keyword comprising a unique identifier of the storage medium associated with the video image over a second communication channel as claimed. Therefore, the combination of Dodson, Feinleib, Shoff and Portuesi fails to teach or suggest at least the aforementioned elements as recited in claim 31.

Claims 32-34 depend upon claim 31, and therefore, are also not obvious over the combination of the Dodson, Feinleib, Shoff and Portuesi references at least for the reason described above with respect to claim 31.

7. Claim 36 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,184,877 (Dodson et al.) in view of U.S. Patent Application No. 2004/0040042 (Feinleib) in further view of U.S. Patent No. 6,240,55 (Shoff et al.), U.S. Patent No. 6,499,057 (Portuesi), and U.S. Patent No. 5,819,284 (Farber et al).

Claim 36 depends from claim 31. As demonstrated above, the combination of Dodson, Feinleib, Shoff, and Portuesi fails to teach or suggest each element of claim 31. Farber also fails to teach or suggest at least “receiving keywords comprising a unique identifier of the storage medium...” as recited in claim 31. Therefore, the combination of Dodson, Feinleib, Shoff, Portuesi, and Farber does not render claim 31 obvious, and thus, a *prima facie* case of obviousness is not met with regard to dependent claim 36.

CONCLUSION

Applicants respectfully submit that the above amendments and remarks place the pending claims in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Dated: November 13, 2006

Respectfully submitted,

/Steven M. Freeland/

Steven M. Freeland
Reg. No. 42,555
Attorney for Applicants
(858) 552-1311

Address all correspondence to:
FITCH, EVEN, TABIN & FLANNERY
Thomas F. Lebens
120 So. LaSalle Street, Ste. 1600
Chicago, IL 60603
(858) 552-1311